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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSAN Q. SANDERS and GLEN N. SANDERS JR.

Appeal 2008-1004
Application 10/776,069
Technology Center 2100

Decided: December 10, 2008

Before LANCE LEONARD BARRY, JOSEPH L. DIXON, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-42. We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

According to Appellants, the invention relates to an Internet Directory System that increases website visibility, creates profitable Internet related businesses and generates a stable revenue stream for website directories and Internet Service Providers, or the like (Spec. 1, ll. 10-16).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. An improved Internet Directory System, comprising:

at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs);

the plurality of CDWs each providing at least a lower level directory referencing websites (WSs) relating to a category;

the CDWs being identified as Category Directory Websites participating in the System by at least a mark or a URL portion; and

a business model imposed on at least the CDWs.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Morimoto

US 2002/0013774 A1

Jan. 31, 2002

Google (www.google.com, webpages from 2/22/2002).

eBay (www.ebay.com, webpages from 11/15/2002).

Yahoo (www.yahoo.com, webpages from 12/09/2002).

Pricewatch (www.pricewatch.com, webpages from 1/28/2003).

Claims 21 and 36 stand rejected under 35 U.S.C. § 112, first and second paragraphs;

Claims 16 and 17 stand rejected under 35 U.S.C. § 112, second paragraph;

Claims 18, 26, and 38 stand rejected under 35 U.S.C. § 112, second paragraph;

Claims 1-11, 13-37, 39, 41, and 42 stand rejected under 35 U.S.C. § 103(a) over the teachings of Pricewatch and Yahoo;

Claim 12 stands rejected under 35 U.S.C. § 103(a) over the teachings of Pricewatch, Yahoo, and Morimoto;

Claim 38 stands rejected under 35 U.S.C. § 103(a) over the teachings of Pricewatch, Yahoo, and eBay; and

Claim 40 stands rejected under 35 U.S.C. § 103(a) over the teachings of Pricewatch, Yahoo, and Google.

We AFFIRM.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in concluding that

A. Claims 21 and 36 are unpatentable under 35 U.S.C. § 112, first and second paragraphs, and in particular, whether the phrase “more than simply geographic” complies with the written description requirement and sufficiently defines the invention being claimed.

B. Claims 16 and 17 are unpatentable under 35 U.S.C. § 112, second paragraph, and in particular, whether the acronym “TLD” has a sufficient antecedent basis.

C. Claims 18, 26, and 28 are unpatentable under 35 U.S.C. § 112, second paragraph, and in particular, whether the phrase “cutting-edge technology” complies with the definiteness requirement.

D. Claims 1-42 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Pricewatch and Yahoo, and in particular, whether 1) all elements of the claimed invention are disclosed or suggested by the applied references; and 2) whether one of ordinary skill in the art would have found it obvious to combine the applied references.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellants' Invention

1. Appellants disclose a Directory Website 14 which registers with a Domain Registration Site 11, wherein a licensing and usage fee is paid to get a special TLD (the 3 letter extension after the dot) designating the site as a Directory Website (p. 12, ll. 21-23).

Pricewatch

2. Pricewatch discloses an internet directory of "New Computer Components" (p. 1).
3. For each item (New Computer Component) in the internet directory, there is a lower level directory of "Systems - Windows Links" (p. 2, bottom).
4. For each item in the lower level directory (Computer Systems – Windows Complete Athlon XP 2200 CD COA), there are "Buy Online" URLs provided to participate in the Pricewatch purchase (p. 3).
5. To participate in Pricewatch (Advertiser Application), Advertisers must meet requirements imposed, including having "established website with prices posted" (p. 5, bottom).

Yahoo

6. Yahoo discloses a Commercial Directory of directories arranged by "Most Popular" as well as "Alphabetical," including "Business.com," "BPubs.com," and the like (p. 1-2).

IV. PRINCIPLES OF LAW

“The specification shall contain a written description of the invention... in such full, clear, concise, and exact terms as to enable any person skill in the art to which it pertains, or with which it is most nearly connected, to make and use the same” 35 U.S.C. § 112, first paragraph.

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention” 35 U.S.C. § 112, second paragraph.

“Our analysis begins with construing the claim limitations at issue.” *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

“[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d at 1313 (Fed. Cir. 2005) (en banc).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

“Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742. The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 127 S. Ct. at 1742. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.*

V. ANALYSIS

Rejection under U.S.C. § 112

The phrase “more than simply geographic” does not comply with the written description requirement:

The Examiner finds that “more than simply geographic” is not sufficiently described in the Specification and does not sufficiently define what is being claimed (Ans. 4). Appellants contend that “[m]ore than simply geographic” distinguishes the invention from the Yellow Pages example of the prior art as discussed in the Background section of the application” since “Yellow Pages are organized geographically” (Reply Br. 2). The issue we address on appeal is whether the phrase “more than simply geographic” complies with the written description requirement and sufficiently define the invention being claimed.

We begin our analysis by giving “more than simply geographic” its ordinary meaning. We agree with the Appellants that a category that is more than simply geographic is thus distinguishable from a category that is geographic. Thus, we agree with the Appellants that this term sufficiently defines the invention that is claimed.

However, we agree with the Examiner that the Specification does not contain a written description of “more than simply geographic” in full, clear, concise, and exact terms, as required by 35 U.S.C. § 112, first paragraph. In fact, Appellants have not identified any instance of the use of the term “geographic” in the Specification.

Though Appellants contend that “[m]ore than simply geographic” distinguishes the invention from the Yellow Pages example of the prior art as discussed in the Background section of the application,” and that “Yellow Pages are organized geographically,” Appellants’ Background section does not clearly set forth such a distinction from the Yellow Pages. In fact, Appellants’ Background section does not even clearly set forth that the Yellow Pages are organized geographically. We, thus, agree with the Examiner and find that “more than simply geographic” does not comply with the written description requirement.

The acronym “TLD” has sufficient antecedent basis:

The Examiner finds that there is insufficient antecedent basis for the limitation “TLD” (Ans. 5). Appellants contend that “[t]he meaning of ‘TLD’ was pointed out, e.g. on page 12 line 22 of the specification” (Reply Br. 2). Therefore, the issue we address on appeal is whether the acronym “TLD” has a sufficient antecedent basis.

We begin our analysis by giving “TLD” its ordinary meaning. We agree with the Appellants that the ordinary meaning of “TLD” is “top level domain” (Reply Br. 2).

Appellants’ Specification defines a special TLD as the 3 letter extension after the dot for designating the site as a Directory (FF 1). We agree with the Appellants and find that “TLD” has sufficient antecedent basis in the Specification.

The phrase “cutting-edge technology” does not comply with the definiteness requirement:

The Examiner finds that the term “cutting edge technology” is a relative term which renders the claim indefinite (Ans. 5). Appellants argue that “‘Cutting-edge technology’ is a defined and well known phrase that would be used by and recognized by one of ordinary skill in the art” (Reply Br. 2). Therefore, the issue we address on appeal is whether the phrase “cutting-edge technology” complies with the definiteness requirement.

We begin our analysis by giving “cutting edge technology” its ordinary meaning. We agree with the Appellants that a category that “cutting-edge technology” is a well-known phrase used and recognized by one of ordinary skill in the art. Thus, we give the term “cutting edge technology” its ordinary meaning of “technology of the greatest advancement or importance.”

However, we agree with the Examiner that such term “cutting-edge” with a meaning of “greatest advancement or importance” is a relative term that renders the claim indefinite. That is, such relative term is indefinite in that it is subject to change, because a particular cutting-edge technology at the time of the invention may be replaced by another technology at a future time as cutting-edge. Thus, “cutting-edge” does not distinctly set forth the subject matter which the applicant regards as his invention, as required by 35 U.S.C. § 112, second paragraph. Thus, we agree with the Examiner and

find that “cutting-edge technology” does not comply with the definiteness requirement.

Rejection under U.S.C. § 103(a)

Each of every element of the claims is found in the prior art teachings:

Appellants do not provide separate arguments with respect to the rejection of claims 1-11, 13-37, 39, 41, and 42. Therefore, we select independent claim 1 as being representative of the cited claims. 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that the “PriceWatch does not adequately or clearly point out where, specifically, the Examiner identifies a ‘category directory website’ in PriceWatch,” (App. Br. 5) and thus does not disclose “at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)” (App. Br. 6). However, the Examiner finds that Yahoo discloses such limitation (Ans. 7). Therefore, the issue we address on appeal is whether the combined teaching of Pricewatch and Yahoo discloses “at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)” (claim 1).

We generally agree with the Examiner's finding that the combined teaching of Pricewatch and Yahoo discloses and/or suggests the claimed elements on appeal beginning at page 6 of the Answer, and the Examiner's corresponding responsive arguments beginning at page 18 of the Answer.

Pricewatch discloses an internet directory, wherein, for each field or category in the internet directory, there is a lower level directory (FF 2-3). Yahoo discloses a Commercial Directory of internet directories (FF 6). We find the internet directory of Pricewatch to be a directory of fields and categories, which references a plurality of for-profit websites. Further, we find the Commercial Directory of Yahoo to be an upper-level directory which references a plurality of websites each providing at least a lower level directory referencing websites. We thus agree with the Examiner that the combined teaching of Pricewatch and Yahoo would disclose or at the least suggest "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)" (Ans. 19).

Though Appellants appear to be arguing that Pricewatch alone fails to disclose the claim limitation, the Examiner has rejected the claims based on the combination of Pricewatch and Yahoo, and nonobviousness cannot be shown by attacking the references individually. We agree with the Examiner's finding that the combined teachings of Pricewatch and Yahoo

discloses “at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs),” as recited in claim 1. An artisan will be able to fit the teachings of Pricewatch and Yahoo together like pieces of a puzzle because person of ordinary skill is also a person of ordinary creativity, not an automaton. *See KSR*, 127 S. Ct. at 1742.

Appellants also argue that the Examiner fails to find CDWs “[i]dentified as Participating in the System by at Least a Mark or a URL Portion” (App. Br. 6). However, the Examiner finds that Pricewatch “shows participation in the system is contained in every participating are in fact identified by the ‘Buy Online’ URL” (Ans. 20). Therefore, the issue we address on appeal is whether the Appellants have shown error in the Examiner’s finding that Pricewatch discloses “participating in the System by at least a mark or a URL portion” (claim 1).

Pricewatch discloses that, for each category in the lower level, there are “Buy Online” URLs provided to participate in the Pricewatch (FF 4). We agree with the Examiner’s finding that Pricewatch discloses or at the least suggests a mark or URL portion, as set forth beginning at page 6 of the Answer, and the Examiner’s corresponding arguments on 19 of the Answer.

Though Appellants contend that “no reasonable consumer would view a ‘Buy Online’ link as a mark, or a URL portion, which identifies an entity,

such as a Category Directory Website, as participating in an Improved Internet Directory System,” Appellants’ claims simply do not place any limitation on what the “mark” or “URL portion” is to be, to represent, or to mean, other than that Category Directory Websites are identified as participating in the System by the mark or URL portion. We find that the “Buy Online” link is a mark/URL portion that identifies whether the participating advertiser/website is participating in the Pricewatch, and thus, the user is able to buy the item online from the participant/website.

We thus agree with the Examiner’s finding that one of ordinary skill in the art would have understood the “Buy Online” link of Pricewatch in view of the teaching of Yahoo to be a mark or a URL portion which identifies CDW websites participating in the system.

Appellants further contend that the Examiner fails to find “a business model imposed on at least the CDWs” (App. Br. 6). However, the Examiner finds that “Pricewatch does in fact have a business model imposed on the participants” (Ans. 20), and further Yahoo “imposes the business model of a company on the CDWs in the Yahoo upper-level directory” (Ans. 20). Therefore, the specific issue is whether the Appellants have shown error in the Examiner’s finding that the combined teaching of Pricewatch and Yahoo discloses “a business model imposed on at least the CDWs” (claim 1).

Pricewatch discloses that, to participate in Pricewatch (Advertiser Application), Advertisers must meet requirements imposed, including having “established website with prices posted” (FF 5). We generally agree

with the Examiner's finding that such teaching of Pricewatch discloses or at the least suggests a business model imposed on the participants, as set forth beginning at page 6 of the Answer and the corresponding arguments on page 20 of the Answer. In particular, we find the requirements imposed on the participating website, such as the requirement of an established website with the prices posted, to be a business model imposed on the website.

We thus agree with the Examiner's finding that one of ordinary skill in the art would have understood the requirements for participation of Pricewatch in view of the teaching of Yahoo to be a business model imposed on the participating CDWs.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in finding all elements of the claimed invention are disclosed or suggested by the combined teaching of Pricewatch and Yahoo.

On of ordinary skill in the art would have found it obviousness to combine the prior art teachings:

Appellants argue that "[t]he Examiner does not adequately demonstrate motive for combining any prior art to reach applicant's invention" (App. Br. 7). Therefore, the specific issue is whether the Appellants have shown error in the Examiner's findings about why one of ordinary skill in the art would have it obvious to combine the teachings of Pricewatch and Yahoo.

The Examiner's finding that it would have been obvious to combine Pricewatch and Yahoo beginning at page 7 of the Answer, and the

corresponding argument beginning at page 20 of the Answer, comply with the requirements of the above-noted case law. Pricewatch discloses an internet directory, wherein, for each field or category in the internet directory, there is a lower level directory (FF 2-3). Yahoo discloses a Commercial Directory of internet directories (FF 6). We thus agree with the Examiner's finding that one of ordinary skill in the art would have incorporated the internet directory of fields categories of Pricewatch to the directory of subdirectories of Yahoo, "to improve the invention by combining two well-known business concepts on two well-known internet sites into one" because it "gives the user the advantage of having more and better choices as a consumer" (Ans. 7).

Appellants have provided no evidence that incorporating the internet directory of fields/categories of Pricewatch to the directory of subdirectories of Yahoo was "uniquely challenging or difficult for one of ordinary skill in the art," *Leapfrog*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) nor have Appellants presented evidence that this incorporation yielded more than expected results. Rather, we find that Appellants claimed invention is simply an arrangement of the known teaching of a directory of fields/categories, to the known teaching of a directory of subdirectories. "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*,

127 S. Ct. at 1740 (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976)).

Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting claim 1, and claims 2-11, 13-37, 39, 41, and 42 falling with claim 1, under 35 U.S.C. § 103(a).

Appellants do not provide separate arguments with respect to the rejection of dependent claims 12, 38, and 40, depending from independent claims 1 and 22, respectively. As discussed above, we find no deficiency regarding the combined teachings of Pricewatch and Yahoo in the rejection of claims 1 and 22. Thus, we conclude that the Appellants have not shown that the Examiner erred in rejecting claim 12 over Pricewatch, Yahoo, and Morimoto, in rejecting claim 38 over Pricewatch, Yahoo, and eBay, and in rejecting claim 40 over Pricewatch, Yahoo, and Google, under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

(1) Appellants have shown that the Examiner erred in finding that claims 21 and 36 are unpatentable under 35 U.S.C. § 112, second paragraph, but have not shown that the Examiner erred in finding that claims 21 and 36 are unpatentable under 35 U.S.C. § 112, first paragraph.

(2) Appellants have shown that the Examiner erred in finding that claims 16 and 17 are unpatentable under 35 U.S.C. § 112, second paragraph.

(3) Appellants have not shown that the Examiner erred in finding that claims 18, 26, and 28 are unpatentable under 35 U.S.C. § 112, second paragraph.

(4) Appellants have not shown that the Examiner erred in finding that claims 1-11, 13-37, 39, 41, and 42 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Pricewatch and Yahoo.

(5) Appellants have not shown that the Examiner erred in finding that claim 12 is unpatentable under 35 U.S.C. § 103(a) over the teachings of Pricewatch, Yahoo, and Morimoto.

(6) Appellants have not shown that the Examiner erred in finding that claim 38 is unpatentable under 35 U.S.C. § 103(a) over the teachings of Pricewatch, Yahoo, and eBay.

(7) Appellants have not shown that the Examiner erred in finding that claim 40 is unpatentable under 35 U.S.C. § 103(a) over the teachings of Pricewatch, Yahoo, and Google.

(8) Claims 1-42 are not patentable.

DECISION

The Examiner's rejection of claims 21 and 36 under 35 U.S.C. § 112, first paragraph is affirmed. The Examiner's rejection of claims 16, 17, 21, and 36 under 35 U.S.C. § 112, second paragraph is reversed. The Examiner's rejection of claims 18, 26, and 28 under 35 U.S.C. § 112, second

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paragraph is affirmed. The Examiner's rejection of claims 1-42 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

rwk

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